

Remarks

I. Introduction

This is in response to the Office Action dated July 9, 2003. The Office Action rejected claims 1, 4-13, 14 and 17-26 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,385,305 (Gerszberg et al.). Claims 27, 28, and 30-33 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,724,411 (Eisdorfer et al.). Applicants traverse the rejections.

Applicants have amended claims 1 and 14 herein in order to more particularly point out and distinctly claim the subject matter which the applicants regard as their invention. Claims 2, 3, 15, 16, 29 and 34 – 43 have been previously cancelled. Claims 1, 4-14, 17-28 and 30-33 are currently pending and remain for consideration. The specification has been amended to correct a typographical error.

II. Rejection Under 35 U.S.C. §102(e)

Claims 1, 4-13, 14 and 17-26 were rejected under 35 U.S.C. §102(e) as being anticipated by Gerszberg et al. In order for a claim to be anticipated under 35 U.S.C. §102, **each and every** limitation of the claim must be found either expressly or inherently in a single prior art reference. PIN/NIP, Inc. v. Platte Chem. Co., 304 F.3d 1235, 1243 (Fed. Cir. 2002). In the present case, Gerszberg et al. does not show each and every limitation of claims 1, 4-13, 14 and 17-26. Therefore, applicants request the withdrawal of the rejection under 35 U.S.C. §102(e).

Claim 1 contains the limitation of “multiple ports identified by at least one designation element”. In one embodiment, the designation element may be, for example, a directory number (see dependent claim 13). The Office Action cites Gerszberg et al. at col. 8, lines 31-32 as disclosing a designation element. The Office Action is unclear as to what portion of Gerszberg et al. it is relying upon to disclose that the designation element identifies multiple ports. Either 1) the Office Action is relying upon col. 8, lines 31-32; or 2) the Office Action cites no portion of Gerszberg et al. as disclosing this claim

element. In either case, this element of claim 1 renders claim 1 allowable over the Gerszberg et al. reference. Col. 8, lines 31-32 of Gerszberg et al. is in a paragraph of Gerszberg et al. which is discussing the toolkit for recording customized greetings. Neither the particular cited lines, nor the remainder of the paragraph, have any disclosure or suggestion of “multiple ports identified by at least one designation element”. Since Gerszberg et al. is lacking a disclosure of this claim element, Claim 1 is not anticipated by Gerszberg et al.

Claim 1 also contains the limitation of a processing unit which “routes a signal received by said transceiver to one of said multiple ports selected by an end user using said greeting”. The Office Action cites Gerszberg et al. at col. 8, lines 27-31 as disclosing a processor which routes a signal received by a transceiver. Once again, the Office Action is unclear as to what portion of Gerszberg et al. it is relying upon to disclose that the one of the multiple ports is selected by the end user using the greeting. Either 1) the Office Action is relying upon col. 8, lines 27-31; or 2) the Office Action cites no portion of Gerszberg et al. as disclosing this claim element. In either case, this element of claim 1 renders claim 1 allowable over the Gerszberg et al. reference. Col. 8, lines 27-31 is in the same paragraph of Gerszberg et al. described above which is discussing the toolkit for recording customized greetings. Neither the particular cited lines, nor the remainder of the paragraph, have any disclosure or suggestion of a processing which “routes a signal received by said transceiver to one of said multiple ports selected by an end user using said greeting”. There is no disclosure nor suggestion in the cited section of Gerszberg et al. which is at all related to an end user selecting one port out of multiple ports and where that selection is made by the end user using the greeting. Since Gerszberg et al. is lacking a disclosure of this claim element, claim 1 is not anticipated by Gerszberg et al. for this additional reason.

Independent claim 14 was also rejected under 35 U.S.C. §102(e) as being anticipated by Gerszberg et al. Claim 14 contains limitations similar to the limitations of claim 1 described above, and is therefore allowable for the same reasons as described above in connection with claim 1.

Dependent claims 4-13 and 17-26 were also rejected under 35 U.S.C. §102(e) as being anticipated by Gerszberg et al. These claims all depend from an allowable

independent claim and are therefore also allowable. These dependent claims also add additional patentable subject matter as follows.

Dependent claim 4 is directed to an aspect of the invention in which the processing unit provides a message after the greeting. Thus, in accordance with this claim, first the greeting is provided and then the message is provided. The Office Action cites Gerszberg et al. at col. 10, lines 15-19 as disclosing this limitation. This section of Gerszberg discloses the possibility of displaying different messages to different people. It does not disclose first providing a greeting and then providing a message after the greeting. Since the cited section of Gerszberg et al. does not disclose this aspect of the invention, claim 4 is allowable.

Dependent claim 8 and 21 are directed to an aspect of the invention in which an end user device provides a distinctive ring. The Office Action cites Gerszberg et al. at col. 5, lines 35-38 as disclosing this limitation. This section of Gerszberg et al. discloses that a telephone may be programmed to provide a digital audio channel at a particular time. Providing a digital audio channel over a telephone is not the same as an end user device providing a distinctive ring. Since the cited section of Gerszberg et al. does not disclose a distinctive ring, Gerszberg et al. cannot anticipate this claim under 35 U.S.C. §102(e).

Dependent claim 9 and 22 are directed to an aspect of the invention in which an end user device displays or announces an identity of a port selected by the end user. The Office Action cites Gerszberg et al. at col. 6, lines 16-17 as disclosing this limitation. This section of Gerszberg et al. merely discloses that a telephone may include a display screen. The mere disclosure of a display screen in no way discloses this claim limitation. The cited section of Gerszberg et al. does not disclose this claim limitation and therefore Gerszberg et al. cannot anticipate this claim under 35 U.S.C. §102(e).

For the reasons described above, claims 1, 4-13, 14 and 17-26 are not anticipated by Gerszberg et al. under 35 U.S.C. §102(e) because Gerszberg et al. does not disclose each and every limitation of the claims.

III. Rejection Under 35 U.S.C. §103

Claims 27, 28 and 30-33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Eisdorfer et al. in view of Gerszberg et al. However, Gerszberg et al. is unavailable as a reference for use in a §103(a) rejection. Under 35 U.S.C. §103(c) a patent to another which qualifies as prior art only under subsection §102(e) shall not preclude patentability under §103 where the patent and the claimed invention were, at the time the invention was made, owned by the same person. 35 U.S.C. §103(c). This portion of the statute is applicable to patent applications filed on or after November 29, 1999. In the present case, Gerszberg et al. qualifies as prior art only under §102(e) and the present application and Gerszberg were, at the time the present invention was made, both owned by AT&T Corp. This joint ownership is evidenced by the following:

- assignment document dated December 29, 1999 recorded at reel/frame 010496/0761 assigning the present invention to AT&T Corp.; and
- assignment document dated March 11, 1998; March 24, 1998; May 8, 1998; recorded at reel/frame 9285/0437 assigning the invention claimed in U.S. Patent No. 6,385,305 to AT&T Corp.

The present application was filed on December 30, 1999, which is after the effective date (November 29, 1999) of the relevant portion of 35 U.S.C. §103(c). Therefore, Gerszberg et al. is unavailable as a reference for use in an obviousness rejection.

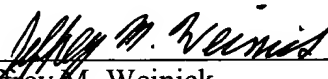
In view of the unavailability of Gerszberg et al. as a reference under 35 U.S.C. §103(c), Applicants request withdrawal of the obviousness rejection under 35 U.S.C. §103(a).

IV. Conclusion

Claims 1, 4-13, 14 and 17-26 are not anticipated by Gerszberg et al. under 35 U.S.C. §102(e) because Gerszberg et al. does not disclose each and every limitation of the claims. Applicants request the withdrawal of the rejection of claims 27, 28 and 30-33 under 35 U.S.C. §103(a) because Gerszberg et al. is unavailable as a references under §103(c).

For the foregoing reasons, reconsideration and allowance of all claims is respectfully requested.

Respectfully submitted,



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